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07/841,617 02/25/92 NEUMEYER

J RBI-101XX

EXAMINER

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ART UNIT PAPER NUMBER

2203

8

DATE MAILED: 08/26/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-45 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-45 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merit is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

The claims in the case are claims 1-45.

Claims 1-45 are drawn to more than one patentably distinct (under 35 U.S.C. 121) area of invention, joined together via means of "Markush" type (group) claims, and accordingly, election of a single species of active compound is required as per the provisions of M.P.E.P. 803.

The claims as presented contain such a vast multitude of "possibilities and permutations" that are present that it is not possible to identify each and every species encompassed in the claims. Accordingly, to facilitate election, applicants are required to elect a single specific compound including the structure and upon such election the Examiner will review the claims and indicate (a) which compounds are so similar thereto as to be part of the elected matter and, (b), by such indication (i.e. by exclusion) which compounds are drawn to non-elected matter. Further, whatever compounds are (ultimately) treated together so too will the corresponding precursor (e.g. claims 25-28) and kit (e.g. claims 29-45) be part of the elected matter.

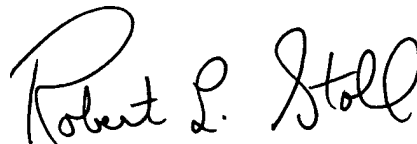
It is considered that the "Markush" type claims encompassing such species are directed to multiple "independent and distinct inventions" since the species encompass compounds that are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claims obvious under 35 USC 103 with respect to any of the other species. Further, these claims encompass species that are considered to be independent since they are unconnected in operation; one does not require the others for ultimate use and the specification does not disclose a dependent relationship between them. Moreover, there are encompassed species that are considered to be distinct from others on the basis of their properties. Also, it is an undue burden on the PTO to act on more than one invention in one case. Thus, this application contains species that are capable of supporting separate patents under 35 USC 121.

Accordingly, applicants are required to make a provisional election of a single independent and distinct specie as noted supra, prior to the examinations of said claims on the merits. This election

will be given effect in the event that the "Markush" type claim(s) is (are) not found allowable, at which time the examination of the claims presented will be limited to the "Markush" type claim(s) directed solely to the elected species, with claims directed solely to the nonelected species being held withdrawn from further consideration. It should be noted that an election of species has been held to be tantamount to a requirement for restriction (In re Herrick, 1958 C.D. 1 and In re Joyce, 1958 C.D. 2) and enjoys the benefit of 35 U.S.C. 121.

Applicants response must include a provisional election as noted supra, even though the requirement be traversed (37 CFR 1.143). Applicants are also advised that any traversal must be supported by specific argument(s) in order to perfect the right to petition in the event that the provisional requirement is given effect in the event noted supra. Applicants are also advised that arguments adequate to cause withdrawal of this requirement would warrant the ultimate conclusion that all species are patentably indistinct and a references for one species would be considered a reference as to all species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Matthew Zmurko whose telephone number is (703) 308-3957. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0511.


ROBERT L. STOLL
SUPERVISORY PRIMARY EXAMINER
ART UNIT 223